



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,988	04/12/2004	Philip A. Carpino	PC25783A	3340

28523 7590 02/03/2006
PFIZER INC.
PATENT DEPARTMENT, MS8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

EXAMINER

OWENS, AMELIA A

ART UNIT PAPER NUMBER

1625

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26 in part, drawn to compounds of formula I where A is N, classified in class 544, subclass 1+.
- II. Claims 1-26 in part, drawn to compounds of formula I where A is C(R2), classified in class 546, subclass 1+.
- III. Claims 30,33,34,35, drawn to method of treating a disease, condition disorder modulated by a cannabinoid receptor agonist with a compound of formula I, classified in class 514, subclass various dependent on species elected. If this group were elected an election of a species compound and a specific disease is required. Further restriction would be required.
- IV. Claims 27-29, drawn to composition comprising multiple active ingredients, classified in class 514, subclass various dependent on species elected. If this group were elected an election of a species compound and a specific disease is required. Further restriction would be required.
- V. Claims 31,32,36-44, drawn to method of treating a disease, condition disorder modulated by a cannabinoid receptor agonist with a compound of formula I and additional pharmaceutical active ingredients, classified in class 514, subclass various dependent on species elected. If this group were elected an election of a species compound and a specific disease is required. Further restriction would be required.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-II are drawn to compounds of diverse structures, which are chemically, physically and patentably distinct from one another. They have acquired a separate status in the art as shown by their different classification. A reference anticipating the pyrazopyridine compound of Group II would not render obvious the pyrazopyrimidine compound of Group I. Since the search is not co-extensive and is burdensome, restriction for examination purposes as indicated is proper.

Art Unit: 1625

Inventions I-II and (II and V) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP j 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product, such as a serotonin receptor modulator or dopamine receptor modulation; the product as claimed can be used in a materially different processes, such as the treatment of obesity, Parkinson's disease or tobacco abuse etc.

The patentability of Group IV invention depends on the type and amount of the multiple active ingredients, the interaction, co-action, e.g. synergism etc., which is patentably distinct from the Group I-IV compositions containing only a single active ingredient. '

The patentability of Group V invention depends on the type and amount of the multiple pharmaceutical active agents, their interaction, co-action, e.g. synergism etc., which is patentably distinct from the Group IV method employing only a single active pharmaceutically active drug compound.

Because these inventions are distinct for the reasons given above and the search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claim: and

Art Unit: 1625

the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1. 104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

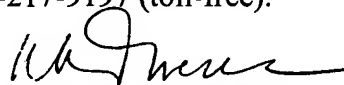
Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AMELIA AVERILL OWENS
PRIMARY EXAMINER